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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/519,017

12/21/2004

Philip Robert Coles

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EXAMINER

MCKANE, ELIZABETH L

ART UNIT

PAPER NUMBER

1797

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/519,017	<b>Applicant(s)</b> COLES ET AL.	
	<b>Examiner</b> ELIZABETH L. MCKANE	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

***Claim Objections***

1. Claim 4 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Specifically, the limitation “said disinfection solution comprises...” fails to further limit the structure of the apparatus in claim 1. Note that the ‘disinfection solution’ was recited in claim 1 only in terms of intended use and thus, has not been positively recited in claim 1.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Ott (US 4,763,678).

With respect to claims 1-4, 7, and 9, Ott teaches a fully automated disinfection system including a housing **25**; an elongated passageway **33,30** supportingly mounted in the housing and constructed for receiving and maintaining the flexible shaft **16** of a probe; a holding member **27** positioned in association with the elongated passageway for receiving and retaining the electronics portion **15** of the probe; a disinfection solution dispensing section **38** having heater **49** disposed therein, **V2** for dispensing a

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disinfection solution to the passageway; a circulation means **46**, and a control means **45**. The circulation means includes a plurality of valves and a pump **46**. See Figure 5. The elongated passageway is continuous and articulately curved along its length. It is noted that the system of Ott is fully capable of disinfecting a transesophageal ultrasonic probe.

As to claim 5, the limitation 'single use' does not patentably or structurally distinguish the reservoir **48** from any other container as the reservoir of Ott may be used a 'single' time.

With respect to claim 6, the system of Ott further includes a closed loop path extending between the proximal end (top) of the passageway, the solution dispensing section, and the distal end (bottom) of the passageway. See Figure 5, wherein overflow tube **35** is connected to reservoir **48**, which is in turn connected to fill tube **38**.

As to claim 8, the heater **49** of Ott is fully capable of maintaining any desired temperature as set by heating controller **50**.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ott in view of Coles (US 6,132,691).

With respect to claim 10, Ott fails to teach an air circulation fan and filter. Coles discloses a probe disinfecting station including a filter **64** and fan **76** for pulling air and odors from the apparatus. It would have been obvious to employ a fan and filter in the apparatus of Ott, as Coles discloses that disinfectants used to disinfect intracavity probes often emit noxious/toxic fumes.

As to claim 11, Ott teaches that control means **45** is 'an industrial programmable controller or control computer...which provides timing signals selected by the user to certain system components to control operation of cleaning system **25**.' See col.5, lines 1-6. Further, in col.5, lines 58-62 discloses that control means **45** directs operation of the valves, pump, and motor, using information from sensors.

With respect to claim 12, Ott discloses a water inlet **65**.

7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ott and Coles as applied to claim 12 above, and further in view of Sanford et al. (US 6,558,620).

Although Ott teaches a computer-based control means **45** that is configured for providing rinse cycles, Ott does not teach rinsing the empty container (reservoir). Sanford et al. discloses an endoscope reprocessor including a control means **80** configured for providing repeated rinse cycles for removing all disinfection solution from the fluid lines, well, and disinfectant reservoir. See Figure 1 wherein water line **42** enters disinfectant reservoir **44** to remove disinfectant therefrom. See col.11, lines 15 to col.13, lines 50. It would have been obvious to one of ordinary skill in the art to employ repeated rinse cycles in the manner of Sanford et al. in order to permit the use of different treating solutions, as disclosed by Sanford et al. to clean and disinfect.

8. Claims 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ott in view of Sanford et al..

With respect to claim 14, Ott is silent with respect to a container seal rupturing means. Sanford et al., however, discloses a replaceable decontaminant container **44** having a seal thereon. Seal cutter **48** automatically opens different compartments in the cup for dispensing into the endoscope reprocessing system. It would have been obvious to use the replaceable container, container receiving means, and seal cutter of Sanford et al. in the invention of Ott, as such permits the user to use a plurality of treatment mediums in a single reservoir.

As to claims 15-17, Ott fails to teach an input panel and printer. Nevertheless, Sanford et al. evidences that it was known in the art at the time of the invention to provide an input panel **354** and printer **358** in an instrument reprocessor. Specifically, Sanford et al. teaches that input panel **354** enables the operator to input commands and

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cycle options to the control panel. The manner in which the control is used is not deemed to structurally distinguish the claimed invention from Sanford et al.. It would have been obvious to add the input panel and printer of Sanford et al. to the apparatus of Ott in order to enable to user to input cycle options and to have a printed record of the cycle, as disclosed by Sanford et al..

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELIZABETH L. MCKANE whose telephone number is (571)272-1275. The examiner can normally be reached on Mon-Fri; 5:30 a.m. - 2:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elizabeth L McKane/  
Primary Examiner, Art Unit 1797

elm  
16 February 2009